

# FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP

PATENT TRADEMARK AND COPYRIGHT LAW

1100 SUPERIOR AVENUE

SEVENTH FLOOR

CLEVELAND, OHIO 44114-2579

TELEPHONE (216) 861-5582

FAX (216) 241-1666 AND (216) 241-5147

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**MAY 16 2005**

DATE: May 16, 2005

TO: U.S. Patent and Trademark Office

ATTENTION: Examiner Duy-Vu N. Deo - Art Unit 1765

FACSIMILE NO.: 1-703-872-9306

FROM: Jay F. Moldovanyi

RE: U.S. Serial No. 10/049,736

Our Reference No.: KSTR 2 00002

Total number of pages (including this cover sheet): 5

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May.16. 2005 3:21PM

No.3030 P. 2

Attorney Docket No.: KSTR 2 00002

# AMENDMENT TRANSMITTAL LETTER

Ser. No.: 10/049,736	Filed: July 22, 2002	Examiner: Duy-Vu N. Deo
Art Unit: 1765	Title: <b>A PROCESS FOR MAKING ISLAND ARRAYS</b>	

To the Commissioner for Patents:

Transmitted herewith is a *Response After Final Rejection and Summary of Interview* in the above-identified application. The fee has been calculated as shown below.

CLAIMS AS AMENDED						
	Claims remaining after amendment		Highest Number Previously Paid For	No. of Extra Claims Present	Rate	Additional Rate
Total Claims	24	Minus	24	0	X \$50	\$0.00
Indep. Claims	4	Minus	4	0	X \$200	\$0.00
TOTAL					=	\$0.00

☒ No additional fee is required.

☐ A check in the amount of \$ \_\_\_\_\_ is attached.

☐ Charge \$ \_\_\_\_\_ to Deposit Account No. 06-0308.

☐ Applicants hereby petition the Commissioner under 37 C.F.R. § 1.136(a) and request a \_\_\_\_\_ month extension of time to respond to the outstanding Office Action. Enclosed is a check in the amount of \$ \_\_\_\_\_ to cover the applicable extension of time fees.

☐ Applicants request any extensions of time that may be necessary and authorize the required fees be charged to Deposit Account No. 06-0308.

☒ Please charge any additional fees or credit overpayment to Deposit Account No. 06-0308.

Respectfully submitted,  
FAY, SHARPE, FAGAN,  
MINNICH & MCKEE, LLP

16 May 2005  
Date

*Jay F. Moldovanyi*  
Jay F. Moldovanyi, Reg. No. 29,678  
1100 Superior Avenue, Seventh Floor  
Cleveland, OH 44114-2579  
216/861-5582

## CERTIFICATE OF MAILING

I certify that this Amendment Transmittal Letter and accompanying document(s) are being

☐ deposited with the United States Postal Service as First Class mail under 37 C.F.R. 1.8, addressed to: MAIL STOP AMENDMENT, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date indicated below.

☒ transmitted to facsimile number 703-872-9306 to Examiner Duy-Vu N. Deo under 37 C.F.R. 1.8 on the date indicated below.

☐ deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated below and is addressed to: MAIL STOP AMENDMENT, Commissioner For Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Express Mail Label No.:	Signature <i>Kathleen A. Nimrichter</i>
Date May 16, 2005	Printed Name Kathleen A. Nimrichter

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May 16, 2005 3:22PM

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No. 3030 P. 3

MAY 16 2005

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Mino Green  
For : A PROCESS FOR MAKING ISLAND  
Serial No. : 10/049,736  
Filed : July 22, 2002  
Group Art Unit : 1765  
Examiner : Duy-Vu N. Deo  
Last Office Action : March 24, 2005  
Attorney Docket No. : BKYZ 200078

RESPONSE AFTER FINAL REJECTION  
AND SUMMARY OF INTERVIEW

Mail Stop Amendment  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

The Examiner and the Supervisory Primary Examiner are thanked for the courtesy of providing an interview to applicant's attorney on May 16, 2005. During the interview, the references to Green and Haginoya were discussed. These documents had been previously addressed in the amendment dated July 28, 2004, as well as in the Office Action dated March 24, 2005.

During the interview, applicant's representative noted that Green and Haginoya

CERTIFICATE OF FACSIMILE

I hereby certify that this Response After Final Rejection in connection with the above identified U.S. Patent Application is being forwarded to the U.S. Patent and Trademark Office via facsimile to Examiner Duy-Vu N. Deo at Facsimile No. 703-872-9306 on this 16th day of May 2005.

Kathleen A. Nimrichter  
Kathleen A. Nimrichter

Date: 5-16-05

are in different technical fields and address different problems. Haginoya dismisses the Green technique of "natural lithography" contending that it has drawbacks, including "its low ability to control structure size, which limits the application range of this technique" (see Haginoya, page 2934, left hand column, first paragraph, last sentence). Haginoya goes on to note that his is "a new technique for fabricating an arrayed nano-structure" (page 2934, first column, second paragraph, first sentence). In other words, the whole disclosure of Haginoya is based on the use of polystyrene beads, rather than solvent islands, such as are disclosed in Green. Moreover, Haginoya dismisses the use of solvent islands (as used in natural lithography) as inaccurate. As a result, it is not believed that the passage discussing natural lithography in Haginoya provides motivation for combining Green with Haginoya.

It was also noted during the interview that even if Haginoya and Green were combined, the combined teaching would still fail to lead the skilled person in the art to the claimed invention. More particularly, Green relates to a technique for forming pillars where resist is present. In contrast, Haginoya relates to a technique for forming wells where resist is absent. Thus, Green and Haginoya are mirror images, or opposites, of each other. There can be no motivation to combine these documents from two differing fields, absent the use of applicant's own claims to provide the motivation. Thus, the rejection uses the benefit of hindsight to make the combination.

But, even if these two references were combined, there is no teaching as to how the two techniques could be combined in order to arrive at the claimed invention. In other words, there is no explanation as to how Green and Haginoya could be combined so as to arrive at the method recited in pending claim 1.

Green contains no indication of how the method could be adapted to form wells or that forming such wells would be desirable. There is nothing in Green indicating that the skilled person in the art would (as opposed to could) even look to adapt a method of Green to produce wells, let alone consult a document, such as Haginoya, to do so. Similarly, Haginoya has nothing complementary to say about depositing a film of a soluble solid onto a hydrophilic substrate and then exposing the film to a solvent vapor so that the film reorganizes into an array of discrete hemispherical islands on the surface. Haginoya contains no teaching which would motivate the skilled person to adapt a method of Haginoya by using solvent islands instead of polystyrene beads.

This missing teaching is only supplied by the claimed invention. However, using applicant's claims against himself is not permitted.

As a result, it is respectfully submitted that claim 1 is in condition for allowance over the applied combination of Green and Haginoya, as well as the remainder of the cited art.

Therefore, dependent claims 2-9, which were also rejected over Green and Haginoya, are also believed to be in condition for allowance over the applied combination.

It is appreciated that claims 10, 14 and 16 are allowable if they were rewritten in independent form. However, it is respectfully submitted that these claims are in condition for allowance as they currently exist, in their dependent form.

Dependent claims 11-13 and 17-20 were rejected over the three-way combination of Green and Haginoya in further view of the Kiyoku et al. 6,153,010 patent. However, Kiyoku does not supply any teaching as to how Green and Haginoya could be combined to arrive at the subject matter which is recited in claims 11-13 and 17-20. Accordingly, it is believed that these claims are also in condition for allowance over the art of record. Claim 15 is similarly believed to be in condition for allowance, although it was not explicitly addressed in the Office Action.


The allowance of claims 21-23 is gratefully acknowledged. It is understood that claim 24 is withdrawn.

In view of the foregoing, it is respectfully submitted that all of pending claims 1-23 are in condition for allowance. Such allowance is earnestly solicited.

Respectfully submitted,

**FAY, SHARPE, FAGAN,  
MINNICH & MCKEE, LLP**

Date: 16 May 2005

  
Jay F. Moldovanyi, Reg. No. 29,678  
1400 Superior Avenue  
Seventh Floor  
Cleveland, OH 44114-2518  
216/861-5582

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